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Paper No. 12

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SUITE 201
BOULDER CO 80303

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MAR 19 2002

OFFICE OF PETITIONS

In re Application of :
Seed, Allen, Aruffo, Camerini, :
Lauffer, Oquendo, Simmons, : DECISION REFUSING STATUS
Stamenkovic, Stengelin, and Amiot : UNDER 37 CFR 1.47(a)
Application No. 09/836,544 :
Filed: 17 April, 2001 :
Attorney Docket No. 11-88L :

This is in response to the petition filed under 37 CFR 1.47(a) on
3 December, 2001.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of
this decision to reply, correcting the below-noted deficiencies.
Any reply should be entitled "Request for Reconsideration of
Petition Under 37 CFR 1.47(a)," and should only address the
deficiencies noted below, except that the reply may include an
oath or declaration executed by the non-signing inventor.
FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.
Extensions of time may be obtained in accordance with 37 CFR
1.136(a).

The above-identified application was filed on 17 April, 2001,
without an executed oath or declaration.

Accordingly, on 19 July, 2001, a Notice to File Missing Parts of
Nonprovisional Application was mailed, requiring the statutory
basic filing fee, additional claim fee(s), an executed oath or
declaration, and a surcharge for their late filing. A two (2)-
month period for reply was set.

In response, on 3 December, 2001 (certificate of mailing date 19 November, 2001), the present petition was filed, accompanied by the statutory basic filing fee, additional claim fee(s), the petition fee and surcharge, and a declaration naming Brian Seed, Janet Allen, Alejandro Aruffo, David Camerini, Leander Laufer, Carmen Oquendo, David Simmons, Ivan Stamenkovic, Siegfried Stengelin, and Martine Amiot as joint inventors and signed by all joint inventors except Stamenkovic on behalf of themselves and joint inventor Stamenkovic.

Petitioners state that the non-signing inventor cannot be located. Specifically, petitioners' counsel states that counsel was informed by joint inventor Seed that Stamenkovic has "returned to Europe without providing a forwarding address."

A grantable petition under 37 CFR 1.47(a) requires:

- (1) proof that the non-signing inventor cannot be reached or located, notwithstanding diligent effort, or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings);
- (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116;
- (3) the petition fee;
- (4) a surcharge of \$130 or \$65 (small entity) if the petition and/or declaration is not filed at the time of filing the application, and
- (5) a statement of the last known address of the non-signing inventor.

The petition lacks items (1), (2), and (5). In regards to item (1), petitioners have not provided proof that diligent efforts have been made to locate the non-signing inventor.¹ Petitioners state that joint inventor Stamenkovic is believed to now be in Europe, however no showing has been provided of any efforts to contact him there. The showing of record is that a single mailing was made to Stamenkovic's US mailing address. Obviously, if Stamenkovic is no longer in the US he cannot be reached at a US mailing address.

Petitioners must present a showing that diligent efforts have been made to locate the non-signing inventor.² The showing of record is insufficient to prove that diligent efforts were made

¹MPEP 409.03(d).

²MPEP 409.03(d).

to locate the non-signing inventor. Petitioner should explain what attempts were made to obtain a forwarding address and to locate the inventor through other means. If attempts to obtain a forwarding address and to locate the inventor by other means (e.g. through e-mail, telephone, national registry) continue to fail, then applicant will have established that the inventor cannot be reached. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having *first hand* knowledge of the details. The specific dates and times that the application was mailed and other attempts, such as telephone calls or e-mail searches, were made should be included.

Petitioners must show proof that a copy of the application (specification including claims, drawings, if any, and the Declaration) were sent or given to the non-signing inventor for review.³ Petitioners should provide a copy of the cover letter transmitting the application papers to the non-signing inventor or details given in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the application is returned as undeliverable by the post office, petitioners should provide a copy of the envelope showing that the application sent to the last known address of the non-signing inventor was returned as undeliverable by the post office. Details of the efforts made to locate the non-signing inventor should be set forth in an affidavit or declaration of facts by a person having first hand knowledge of the details.

In the event that the non-signing inventor refuses to sign the declaration, petitioners must present proof thereof. If there is a written refusal, a copy of the written refusal should be submitted with any renewed petition. If the refusal was made orally to a person, then that person must provide details of the refusal in an affidavit or declaration of facts.

In regards to item (2), the declaration filed on 3 December, 2001, is defective because the citizenship is not included for joint inventors Allen, Camerini, Lauffer, Oquendo, Simmons, Stamenkovic, Stengelin, and Amiot.⁴ A statement of the inventor's citizenship is a statutory requirement and cannot be

³MPEP 409.03(d).

⁴MPEP 605.01.

waived.⁵ Additionally the declaration contains is defective in that it contains non initialed and/or non-dated alterations.⁶ Specifically, there are unsigned or undated changes for joint inventors Lauffer and Oquendo. A new oath or declaration in compliance with 37 CFR 1.63 and 1.67, signed by all of the signing inventors on behalf of themselves and the non-signing inventor must be submitted with a renewed petition.

With regards to item (5) petitioners should verify the last known address for the non-signing inventor. If a different last known address is found, petitioners must state the last known address in any renewed petition.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Assistant Commissioner for Patents
Box DAC
Washington, D.C. 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision should be directed to the undersigned at 703-308-6918.



Douglas I. Wood
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

⁵35 U.S.C. § 115, MPEP 605.01.

⁶See 37 CFR 1.52(c).